



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,943	11/13/2003	Gary Workman	00290P0021US	9536
32116	7590	09/28/2005	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,943

Applicant(s)

WORKMAN, GARY

Examiner

Anish Desai

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

6

DETAILED ACTION

Applicant's Arguments/Remarks

1. The applicant's arguments/remarks received on 09/06/05 in response to the office action dated 05/31/05 are found to be persuasive. The examiner is withdrawing the rejection of claims 1-4, 6, 7-10, and 12 made under U.S.C 102(b) and claims 1-21 made under U.S.C 103(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadley et al. (US Patent 3,545,263) in view of Peacock et al. and further in view of Long Sr. et al. (US Patent 6,276,104).
3. Hadley et al. disclose a compression testing machine (see Title). The machine is designed for testing concrete blocks by compression (Column 1, lines 50-53). The machine of Hadley et al. includes a lower platen and an upper platen. A test piece is placed between the said platens (Column 1, lines 53-59).
4. Hadley et al. are silent with respect to teaching that a plastic sheet laminated to an expanded polystyrene foam board using an adhesive, the expanded polystyrene foam board engaging the face of the concrete masonry unit, the rigid foam board comprises expanded polystyrene foam board with density of 2 lb/ft³ and 3 lb/ft³, the

Art Unit: 1771

thickness of the foam board to be 0.5 inch, and the thickness of the plastic sheet to be about 0.06 inch. Thus, one in the possession of the invention of Hadley et al. would have to look elsewhere.

5. Peacock et al. teach a method and apparatus for supporting concrete testing samples (Abstract). The invention relates to concrete sample testing and support means therefor comprising end caps and removable molded elastomeric insert pads for positioning over the ends of cylindrical concrete sample (Column 1, lines 9-12).

According to Peacock et al., the use of the pads allows uniform load distribution during the loading which in turn results in compressive stress results more truly representing the cylinders (Column 2, lines 3-6).

6. Peacock et al. are silent with respect to teaching a plastic sheet laminated to the expanded polystyrene foam board with an adhesive layer, the thickness of the plastic sheet and polystyrene foam, and the density of the polystyrene foam. Thus, one of ordinary skill in the art would have to look elsewhere to obtain a plastic sheet laminated to the expanded polystyrene foam with an adhesive.

7. Long Sr. et al. teach a thermal insulation foam board that is disposed between the concrete layers and forming of a composite wall using such a foam board (Column 1, lines 60-63). According to Long Sr et al., a thermal insulation foam boards bonded with plastic films (i.e. facer film) of their invention are significantly stronger than the foam boards that lack such films (Column 2, lines 8-12). Thus, Long Sr. et al. provide guidance to one having ordinary skill in the art with regards to bonding a plastic film to a foam board. The facer film can be laminated to the foam board using an adhesive

Art Unit: 1771

(Column 3, lines 60-63), which meets the limitations of claims 6, 12, and 18. The foam board is made of expanded polystyrene foam because such foams are readily recyclable (Column 4, lines 40-44). Additionally, the thickness of the foam panel is from 1 to 4 inch (Column 4, lines 54-55), which meets the claimed thickness of the foam as claimed in claims 5, 11, 17, and 21.

8. Long Sr et al. teaches the claimed invention except for that the thickness of the plastic film as claimed in claims 5, 11, 17, and 21. The thickness of the plastic film is considered a result effective variable. As the thickness of the plastic film increases, the strength of the foam board laminated with the plastic film increases. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the thickness of the plastic film as claimed in claims 5, 11, 17, and 21, since it has been held that the discovering an optimum value of a result effective variable involves only routine skill in the art *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. The density of the polystyrene foam is from 10 kg/m^3 to 150 kg/m^3 . The said density equates to 0.62 lb/ft^3 to 9.36 lb/ft^3 (using $1 \text{ kg/m}^3 = 0.062 \text{ lb/ft}^3$), which meets the limitations of claims 3, 4, 9, 10, 15, 16, and 20.

10. The inventions of Hadley et al., Peacock et al., and Long Sr. et al., are in the same filed of endeavor because it is well known that concrete is used in the building construction.

11. With respect to claims 1-21, a skilled artisan would have found it obvious to use recyclable expanded polystyrene foam board of Long Sr. et al. which is adhesively

Art Unit: 1771

bonded to a plastic facer film in the invention of Hadley et al. motivated by the desire to use a recyclable polystyrene foam that can effectively provide uniform load distribution on the concrete block of Hadley et al. when the block is undergoing compressive loading.

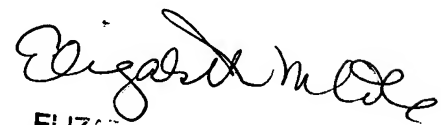
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD


ELIZABETH COLE
PRIVATE EXAMINER